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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. NELSON

Appeal 2009-007072
Application 10/719,063
Technology Center 3600

Decided:¹ August 05, 2009

Before ERIC GRIMES, and RICHARD M. LEBOVITZ, and STEPHEN WALSH, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims 1-20, which are directed to a device and methods for capturing an insect. The Examiner

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

has rejected the claims as anticipated and obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

The Specification discloses capturing insects “by attachment to a pressure responsive adhesive which has been provided on a pliable and compressible substrate in a sheet form. The sheet material has enveloping abilities which enables it to be folded over on itself so that a captured insect may be wrapped up” and disposed of (Spec 2: 7-10). The Specification also discloses “a manual insect capturing device that is absorbent and can collapse in response to the insect[’]s body thus reducing the smashing or squashing effect that occurs when an insect is sandwiched between a rigid article and a hard surface” (*id.* at 3: 13-16).

Claims 1-20 are on appeal. Claim 1 is representative and reads:

1. A device for restraining an insect comprising a planar sheet substrate having a top side and a bottom side, said substrate having an adhesive displaced on said top side to form an engagement area of said top side, said substrate further comprising a compressible, and pliable material, whereby when said sheet is manually manipulated so that when said engagement area on said top side covers an insect and a force is manually applied to said substrate from said bottom side, said insect will cause said substrate to collapse and form a concave depression which conforms to the shape of said insect and therefore partially embed said insect within said substrate.

The claims stand rejected as follows:

- claims 1, 4, 9, 11, 12, and 18 under 35 U.S.C. § 102(b) in view of Hughes;²

² Hughes, US 2,962,836, Dec. 6, 1960

- claims 1-3 and 12 under 35 U.S.C. § 102(b) in view of “Post-It” notes;
- claims 2-3, 5-8, 10, and 17 under 35 U.S.C. § 103(a) in view of Hughes;
- claims 13-16 under 35 U.S.C. § 103(a) in view of Hughes and Sherman;³
- claims 19 and 20 under 35 U.S.C. § 103(a) in view of Hughes, Sherman and Shuster.⁴

ANTICIPATION BY HUGHES

Issue

The Examiner has rejected claims 1, 4, 9, 11, 12, and 18 under 35 U.S.C. § 102(b) as anticipated by Hughes (Answer 3). The Examiner finds that Hughes “shows a device for restraining pests comprising a planar sheet 13 having top side, a bottom side and an engagement area with adhesive” (Office Action mailed March 23, 2005 (“Final Rej.”) at 4). The Examiner reasons that the “substrate will collapse and form a concave depression which conforms to the shape of the pest or insect noting Fig. 4 of Hughes as a user wraps the substrate around the pest” (*id.*).

Appellant contends that the Examiner erred in finding that Hughes discloses a substrate that collapses and forms a concave depression that embeds an insect within the substrate, as required by the claims (Appeal Br. 6).

³ Sherman, Eur. Pat. Appl. No. 0367539, May 9, 1990

⁴ Shuster et al., US 4,052,811, Oct. 11, 1977

The issue with respect to this rejection is: Does the evidence of record support the Examiner's finding that Hughes discloses a compressible substrate that collapses and forms a concave depression which conforms to the shape of said insect and therefore is able to partially embed the insect within the substrate when a force is applied to the substrate from the bottom side as required by claim 1?

Findings of Fact

1. Hughes discloses "a rodent capturing assembly employing a pad of adhesive sheets upon which rodents can be caught by adhesion" (Hughes, col. 1, ll. 30-33).
2. Figure 4 of Hughes is shown below:

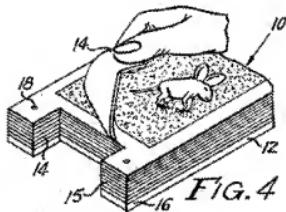


Figure 4 shows a fragmentary perspective view of Hughes' device (*id.* at col. 1, ll. 59-61).

3. Hughes discloses that the "pad 10 is composed of a foundation sheet 12 of substantially heavy paper or cardboard and upon this is placed a stack of adhesive covered sheets 13" (*id.* at col. 1, l. 71 – col. 2, l. 1).

4. Hughes discloses that after a mouse is caught, the top sheet is peeled from the underlying sheet "further adhering the mouse in place as the

sheet being peeled is wrapped and rolled to a convenient form and entirely removed from the pad for proper disposal" (*id.* at col. 2, ll. 63-70).

5. The Specification discloses "a manual insect capturing device that is absorbent and can collapse in response to the insect[']s body thus reducing the smashing or squashing effect that occurs when an insect is sandwiched between a rigid article and a hard surface" (Spec. 3).

6. Figure 15 of the Specification is shown below:

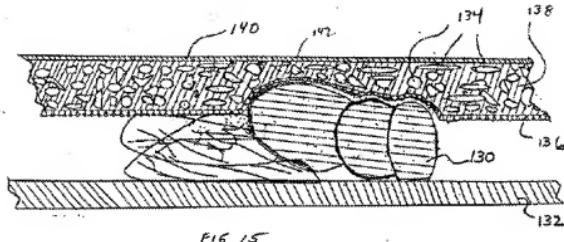


Figure 15 shows a side sectional view of one embodiment of the disclosed device, engaged with an insect against a hard surface (*id.* at 5).

7. The Specification states that in the embodiment shown in Figure 15, "air cavities 134 are distributed throughout the substrate 138 which enables the substrate to be compressed in response to force applied from the bottom surface 142 of the device" (*id.* at 8-9).

8. The Specification states that "alternative materials may be [used] as the compressible substrate such as synthetic resin which is partially elastic and compressible or can collapse along an axis perpendicular with the planar surface on which is provided the adhesive" (*id.* at 9).

9. The Specification states that Figure 15 shows that "[a]pplication of pressure causes the insect[']s body to create a small depression or cavity

within the substrate and increases the total surface areas between the adhesive agent and the insect" (*id.* at 11).

Principles of Law

"To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

Analysis

Claim 1 is directed to an insect restraining device comprising a planar sheet substrate having the property that, when a force is applied to the substrate from the bottom side, an insect will cause the substrate to collapse and form a concave depression that conforms to the shape of the insect and partially embeds the insect within the substrate.

The Examiner reasons that "since Hughes surrounds the pest such as shown in Fig. 4, if the substrate were a bag, the pest would be in the bag which is the same as being embedded within the bag" (Answer 3). The Examiner further reasons that "the substrate of Hughes is compressible since all solid materials can be compressed to some extent. As a material is compressed, it is collapsing" (*id.* at 3-4).

Appellant argues that "folding a substrate around the pest is not the same as causing the substrate itself to collapse. Further, in the Hughes patent the rodent is not *embedded within the substrate*" (Appeal Br. 6). Appellant further argues that there is no disclosure or suggestion in Hughes of a substrate that is compressible such that "pressure from the rear surface

in engagement with an insect will compress the substrate ... so that the substrate will *collapse* and an insect will be embedded" (*id.* at 7).

Appellant's arguments are persuasive. The Specification discloses that the substrate is absorbent and can collapse in response to the insect's body when force is applied from the device's bottom surface, thus reducing the smashing or squashing effect that occurs when an insect is sandwiched between a rigid article and a hard surface. Thus, when claim 1 is read in light of the Specification, the phrase "comprising a compressible, and pliable material" must be interpreted to require more than just folding the substrate around a pest as disclosed in Hughes. Rather, claim 1 requires that the substrate be sufficiently compressible that, in response to a force, it will "collapse and form a concave depression" around an insect's body and partially embed the body in the substrate. Hughes does not disclose that the material that is used to make its substrate has the degree of compressibility required by claim 1. The rejection of claim 1 as anticipated by Hughes is reversed.

Claims 4, 9, 11, 12, and 18 depend from claim 1. The rejection of these claims is reversed for the reasons discussed above.

Conclusion of Law

The evidence of record does not support the Examiner's finding that Hughes discloses the compressible substrate required by the rejected claims.

ANTICIPATION BY POST-IT NOTES

The Examiner has rejected claims 1-3 and 12 under 35 U.S.C. § 102(b) as being anticipated by "Post-It" notes (Answer 3). As with the

rejection based on Hughes, the Examiner reasons that “wrapping the ‘Post-It’ note around an insect by exerting a force on the bottom side will cause the substrate to collapse and form a concave depression in the shape of the pest and therefore partially embed the pest within the substrate” (Fin. Rej. 4).

We reverse this rejection because, for the reasons discussed above, claim 1 requires that the substrate be compressible enough to partially collapse around an insect’s body and partially embed the body in the substrate. The Examiner has not adequately shown that “Post It” notes possess the requisite degree of compressibility.

OBVIOUSNESS I

The Examiner has rejected claims 2-3, 5-8, 10, and 17 under 35 U.S.C. § 103(a) as being obvious in view of Hughes, and claims 13-16 as obvious in view of Hughes combined with Sherman. All of the rejected claims depend directly or indirectly from independent claim 1. The Examiner relies on Hughes for disclosing the invention of claim 1, as discussed above, and concludes that the dependent claim limitations would have been obvious based on Hughes or Sherman (Final Rej. 5).

As discussed above, however, the Examiner has not adequately shown Hughes discloses the substrate required by claim 1. Nor has the Examiner adequately explained why the substrate recited in claim 1 would have been obvious based on Hughes or Sherman. The rejections of claims 2-3, 5-8, 10, and 13-17 are reversed for the reasons discussed above.

OBVIOUSNESS II

The Examiner has rejected claims 19⁵ and 20 under 35 U.S.C. § 103(a) as being obvious in view of Hughes, Sherman, and Shuster. The Examiner relies on Hughes as discussed above and relies on Sherman as showing a pest trap having adhesive dispersed on a substrate in a discontinuous manner (Final Rej. 6). The Examiner relies on Shuster as disclosing “an insect trap having a substrate 26 having an adhesive coating 22 and a compressible material 28 which the substrate is mounted on and which is displaced when an insect is pressured from the bottom side of the substrate” (*id.*). The Examiner concludes that “it would have been obvious to provide the trap of Hughes as modified by EP ‘539 (Sherman) with the method shown by Shuster et al. for the purpose of capturing the insect by employing a[] compressible material to retain the insect without rupturing the insect body” (*id.*).

⁵ Claim 19 reads: “A method of capturing an insect or pest which is found on a surface comprising application of the top side of [the device as recited in claim 1 wherein said adhesive is dispersed over said engagement areas in a discontinuous manner and wherein portions of said substrate are exposed on said top surface in said engagement area wherein the device is in the shape of a flat planar sheet and said engagement layer is the second area of contact as the flat planar sheet is brought into contact with a parallel flat planar surface wherein said engagement area is recessed with respect to said compressible material] to an insect or pest,

applying pressure to the rear of said substrate and thereby allowing said non-adhesive surface to be displaced and to allow said adhesive to contact said insect and to restrain said pest, and

providing additional pressure from said bottom side of said substrate thereby allowing said compressible material to be further compressed by said insect or pest and causing said insect to form a concave depression in said top side of said substrate.

Appellant contends that the Examiner erred in finding that the cited references disclose or suggest a restraining device with a compressible substrate that allows the pest to deform the substrate and form a concave depression in it (Appeal Br. 15).

The main issue with respect to this rejection is: Does the evidence of record support the Examiner's conclusion that the cited references suggest a compressible substrate that collapses and forms a concave depression that conforms to the shape of an insect and partially embeds the insect within the substrate in response to a force applied to the bottom of the substrate?

Additional Findings of Fact

9. Sherman discloses a flying insect control device that is a plastic sheet formed of a mixture of resin and insecticide (Sherman, col. 4, ll. 4-18).
10. Shuster discloses "a household device for catching insects" (Shuster, col. 1, ll. 5-6).

11. Figure 1 of Shuster is shown below:

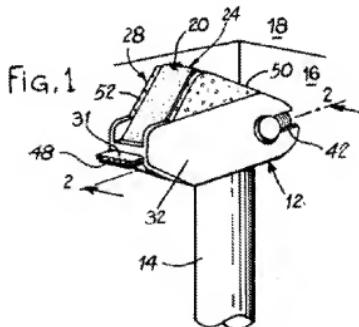


Figure 1 shows

an insect catching device generally denoted by reference numeral 10 ... [that] includes a rigid body generally referred to by reference numeral 12 carried on the upper end of an elongated handle 14. ...

The captured insect 20 as shown is retained on the tacky face 22 of an elongated flexible adhesive tape such as commercial masking tape generally referred to by reference numeral 24. The non-adhesive backing face 26 of the tape is supported on a resilient body such as a sponge-like support pad generally referred to by reference numeral 28.

(*Id.* at col. 1, l. 61 – col. 2, l. 10.)

12. Shuster discloses that the sponge-like pad constitutes “a resilient support to avoid squashing of the insect on the wall or ceiling surface” (*id.* at col. 1, ll. 34-36).

Principles of Law

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant.” *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993).

Analysis

Claim 19 is directed to a “method of capturing an insect or pest which is found on a surface,” using the device of claim 1. Claim 1 requires that the substrate allows for the insect to be partially embedded in the substrate when a force is applied to the bottom side of the substrate.

Shuster discloses that its device “avoid[s] squashing of the insect on the wall or ceiling surface” (FF 12), and therefore the substrate of Shuster’s device may temporarily deform and conform to the shape of an insect’s body upon the application of force. However, the insect sticks to “an elongated flexible adhesive tape such as commercial masking tape” (FF 11) in Shuster’s device, and an insect that is stuck to the surface of a piece of tape is not “embedded” in the tape. The Examiner has not shown the adhesive tape that Shuster discloses as its adhesive surface would result in the insect being embedded in the substrate. That is, Shuster appears to disclose a resilient substrate that will allow the substrate to spring back to its previous form after compression, not one that is sufficiently compressible that the substrate will collapse to form a depression that will embed an insect in the substrate, as required by claim 1. Thus, the Examiner has not adequately shown that the cited references suggest the substrate of claim 1.

Claim 20 depends from claim 19. The rejection of claim 20 is reversed for the reasons discussed above.

Conclusions of Law

The evidence of record does not support the Examiner’s conclusion that the cited references suggest a compressible substrate that collapses and forms a concave depression that conforms to the shape of an insect and partially embeds the insect within the substrate in response to a force applied to the bottom of the substrate.

SUMMARY

We reverse the rejections of claims 1-20 under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) in view of the cited references.

REVERSED

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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998